

Remarks

Claims 35-42 are pending. New Claims 37-42 are added and Claims 1-16 and 19-34 are cancelled in this Response.

Rejections Under 35 U.S.C. § 101

Claim 36 was rejected under Section 101 as being directed to non-statutory subject matter. In support of the rejection, the Examiner asserts (1) "that the recited propagation or transmission media" in the Specification would not "enable the functionality to be realized" and (2) "inclusion of a piece of paper ... within the scope of 'computer-readable medium' indicates the claims are sufficiently broad to read on non-functional descriptive material, printed matter." Office Action, page 3.

Printed Matter Rejection. The printed matter cases have no relevance where, as here, the claims recite information readable by a machine. The Federal Circuit decision in *In Re Lowry* explicitly rejected the notion that printed matter rejections apply to computer readable media:

The printed matter cases "dealt with claims defining as the invention certain novel arrangements of printed lines or characters, useful and intelligible only to the human mind." *In re Bernhart*, 417 F.2d 1395, 1399, 163 USPQ 611, 615 (CCPA 1969). The printed matter cases have no factual relevance where "the invention as defined by the claims *requires* that the information be processed not by the mind but by a machine, the computer." *Id.* (emphasis in original).

In Re Lowry, 32 F.3d 1579, 1583 (Fed. Cir. 1994). The CCPA decision in *In Re Jones* cited by the Examiner does not support the rejection. Rather, Jones is consistent with the Federal Circuit's holding in *Lowry* that computer readable printed paper that includes the claimed logic is not subject to a printed matter rejection:

Certainly there is no "printing" in this case in the form of words or other symbols intended to convey intelligence to a reader nor in the form of rulings as on a business form. The user of the disc is not supposed to contemplate it as he would a mathematical table, weighing scale chart, or the like in order to derive some information. The disc is devised, made and used as a component part of a machine utilizing optics and electronics to perform functions We think it is error to confuse the lines on a patent drawing, which may have the appearance of "printed matter," with functional elements of a mechanism which in use actuate other mechanisms or electrical circuits or devices....

In Re Jones, 373 F.2d 1007, 1011 (CCPA 1967).

There is no relevant structural or functional difference between a compact

disc, for example, and a printed paper if the computer can read the logic recorded on each medium — they are both articles of manufacture from which a computer can read the claimed logic. All that the description on pages 10-11 of the Specification conveys is that any suitable computer readable medium may be used to implement embodiments of the invention, including printed paper. So far as the undersigned is aware, there is no legal authority that supports the proposition that some forms of computer readable media are statutory and some are not. If the Examiner disagrees, he is respectfully requested to cite to pertinent legal authority to support this so-called "printed matter" rejection of a computer medium claim.

Propagation Medium. The Specification includes in the list of examples of possible computer readable media a "propagation medium." Specification, page 10, lines 10-15. (The Specification also states that a computer readable medium can be any means that can "communicate, propagate or transport" a computer program.) The Examiner does not state how or why a propagation medium falls outside the statutory classes enumerated in Section 101 even though any such propagation medium is an article of manufacture or a machine. Indeed, the Patent Office has taken the position that a "computer data signal embodied in a carrier wave" is itself an article of manufacture without regard to the physical medium from, in, through or to which the wave is propagated. See, Examination Guidelines For Computer-Related Inventions, Example: Automated Manufacturing Plant, Claim 13 pages 39-40 and 45 (<http://www.uspto.gov/web/offices/pac/dapp/pdf/compenex.pdf>).

The Examiner also makes no direct assertion that a computer readable propagation medium is not useful. Clearly it is.

Hence, the Examiner has plainly failed to establish a *prima facie* case of non-patentability under Section 101.

In support of the Section 101 rejection, the Examiner makes the following statements at page 3 of the Office Action.

It is not believed, however, that the recited propagation or transmission media would likewise enable the functionality to be realized. Absent recitation of some means for receiving and processing the program, propagation or transmission media are not believed to be, in and of themselves, capable of providing the program in a manner which enables it to be read and executed by a computer, with subsequent realization of its functionality to accomplish a practical application by causing the computer to perform operation with a useful, concrete and tangible result.

First, and with due respect, what Examiner believes or does not believe can in no way support a rejection. Rather, the Examiner is obligated to produce objective evidence to support a rejection.

Second, the apparent factual premise asserted by the Examiner (that a computer could not use the programming included in or on a propagation medium) is not accurate. Programming "propagated" or "transmitted" from one computer to another computer, over the Internet for example, is every bit as functional and useful as programming read from a compact disc.

Third, even if it is assumed for purposes of argument only, and without conceding, that a propagation medium is not useful under Section 101 or it does not enable the computer readable medium of Claim 36 under Section 112, other media listed on page 10 of the Specification are useful and do enable the computer readable medium of Claim 36, as acknowledged by the Examiner at page 3 of the Office Action. The Examiner has not, as yet, cited to any authority supporting the novel proposition that describing a non-useful or non-enabling feature somehow cancels out the description of several useful and enabling features. Absent such a showing, the rejection cannot stand.

Rejections Under 35 U.S.C. § 103

Claims 35 and 36 were rejected under Section 103 as being obvious over Fleming (6530018) and Momose (6822753) in view of Edelstein (6378128). The rejection is based on the assertion that Edelstein teaches determining if the computer operating system includes a Windows installer and then taking the claimed action in response to this determination. The Examiner's remarks on Edelstein are identical to those made before the appeal. The Examiner still has not addressed the distinguishing *facts* detailed in Applicant's appeal brief, which are repeated below. Unless the Examiner has a plausible response, Claims 35 and 36 should be (and should have been) allowed.

Claim 35 recites:

determining if an operating system on the computer includes a Windows installer service;

if it is determined that the operating system does not include a Windows installer service, then removing any driver for the device provided by the operating system and setting up the operating system to use a driver provided with the device; and

if it is determined that the operating system includes a Windows installer service, then updating any driver for the device associated with the Windows installer service with a driver provided with the device.

Claim 36, which is a computer medium counterpart to the method of Claim 35, contains similar limitations.

Edelstein teaches adding an intelligent install module to the Windows Installer to provide functionality for dynamically creating or modifying the install-set for installing an application program. Edelstein, column 6, lines 32-36. Edelstein does not make any determination that the operating system does or does not include a Windows installer. Rather, Edelstein assumes the Windows Installer exists in the operating system. It necessarily follows, therefore, that Edelstein does not take any action in response to any such determination. Specifically, Edelstein does not teach removing a driver if it is determined the operating system does not include a Windows Installer, or updating a driver if it is determined that the operating system does include a Windows Installer. Indeed, Edelstein doesn't have anything to do with device drivers.

The Examiner asserts that "operable to detect" at column 6, line 29 in Edelstein teaches determining that the operating system does not include a Windows Installer. The Examiner's assertion is not correct. The cited passage refers to "a WINDOWS INSTALLER program module that is operable to detect and install a new application program module 136...." This passage doesn't say anything about determining that the operating system does not include a Windows Installer. Indeed, it is clear that the operating system does include a Windows Installer.

The Examiner asserts that "install a new application program module" at column 6, line 31 in Edelstein teaches removing a driver provided by the operating system. The Examiner's assertion is not correct. The cited passage refers to "a WINDOWS INSTALLER program module that is operable to detect and install a new application program module 136...." This passage doesn't say anything about removing a device driver or any other programming.

The Applicant respectfully submits that Edelstein really doesn't have any

relevance at all to the subject matter of Claims 35 and 36. The rejection of Claims 35 and 36 should be withdrawn.

The foregoing is believed to be a complete response to the outstanding Office Action.

Respectfully submitted,

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